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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135

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EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,249

Applicant(s)

MORI ET AL.

Examiner

Yasin M. Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10,11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **Response to Amendment**

1. The amendment filed on September 19, 2005 has been fully considered but are moot in view of the new ground(s) of rejection. Applicant's amendment of adding a user account and password to the electronic mail necessitated the new grounds of rejection.

- Claims 1,3-8, 10, 11 and 13 are amended.
- Claims 9 and 12 are cancelled.
- Claims 1,5-8, 10, 11 and 13 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1,5-8, 10, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848, hereinafter "Arnold") in view of Tanaka et al (U.S. Patent Number 5,905,495, hereinafter "Tanaka". Arnold discloses method and apparatus for automated referencing of electronic information.

In referring to claims 1, 5, 6, 7, 10, and 13, Arnold shows substantial features of the claimed invention, including:

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Attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail: Arnold, Figure 2, element 210 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means)

Attached file transferring step/means for transferring the attached file separated from the electronic mail by the attached file separating means to a predetermined server: Arnold, Figure 2, element 212 shows the step of storing the attachment on a remote site (which inherently implies an attached file transferring means)

Store location information adding step/means for adding store location information ' indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail: Arnold, Figure 2, element 214 shows the step of submitting the attachment with a pointer (which inherently implies a store location information adding means)

However, Arnold does not show adding a user account and password to an electronic mail.

Nonetheless this feature is well known in the art and would have been an obvious modification of the system disclosed by Arnold as evidenced by Tanaka. In analogous art Tanaka discloses a communication system using electronic mail. Tanaka shows adding a user account and password to an outgoing electronic file (Fig. 13 and 16). Given these teachings a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold so as to use both the password and the user ID for identification and a certification information (col. 37, lines 56-64). Tanaka further shows using a user account and password (figs 13 and 16 col. 29, lines 64 to col. 30 line 15)

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Arnold further shows a store location information corresponds to a store server, a store directory, a login account and a password to allow a receiver of the electronic mail to retrieve the attachment: "Another technical advantage is that the invention manages access to a remotely located attachment through use of an attachment access list. Only those individuals or entities named on the access list may have access to the attachment. Preferably only the recipients of the e-mail message are listed on the access list." (Arnold, col. 2, lines 56- 61)

In referring to claim 3, Arnold in view of Tanaka shows,

Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

"...(5) placing the attachment on a remote site; and (6) inserting a pointer into the message, wherein the pointer is linked to the remote site. "(Arnold, col. 2, lines 36-38) A system that appends a pointer, which allows the user to retrieve the e-mail attachment, inherently implies the pointer includes the transfer method for retrieving said file

In referring to claim 4, Arnold in view of Tanaka shows,

The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server:

Arnold, Figure 2 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server.

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In referring to claims 8 and 11, although Arnold in view of Tanaka shows substantial features of the claimed invention, Arnold in view of Tanaka does not explicitly show how the server is chosen. Arnold in view of Tanaka does not explicitly show choosing' a server based on the header of the electronic mail. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Arnold in view of Tanaka. A person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold in view of Tanaka so as to choose the same server every time a specific recipient is to receive an email in order to consolidate all of a recipient's attachments and facilitate easier access to them.

### Conclusion

3. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

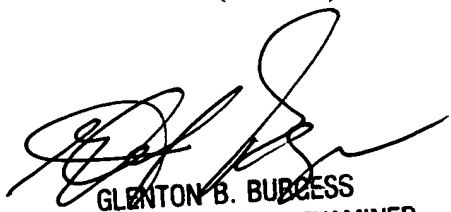
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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